IPREME COURT, U. S.

FILED
SEP 17 1969
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1969

No. 322

MONTECATINI EDISON S.p.a., *Petitioner,*

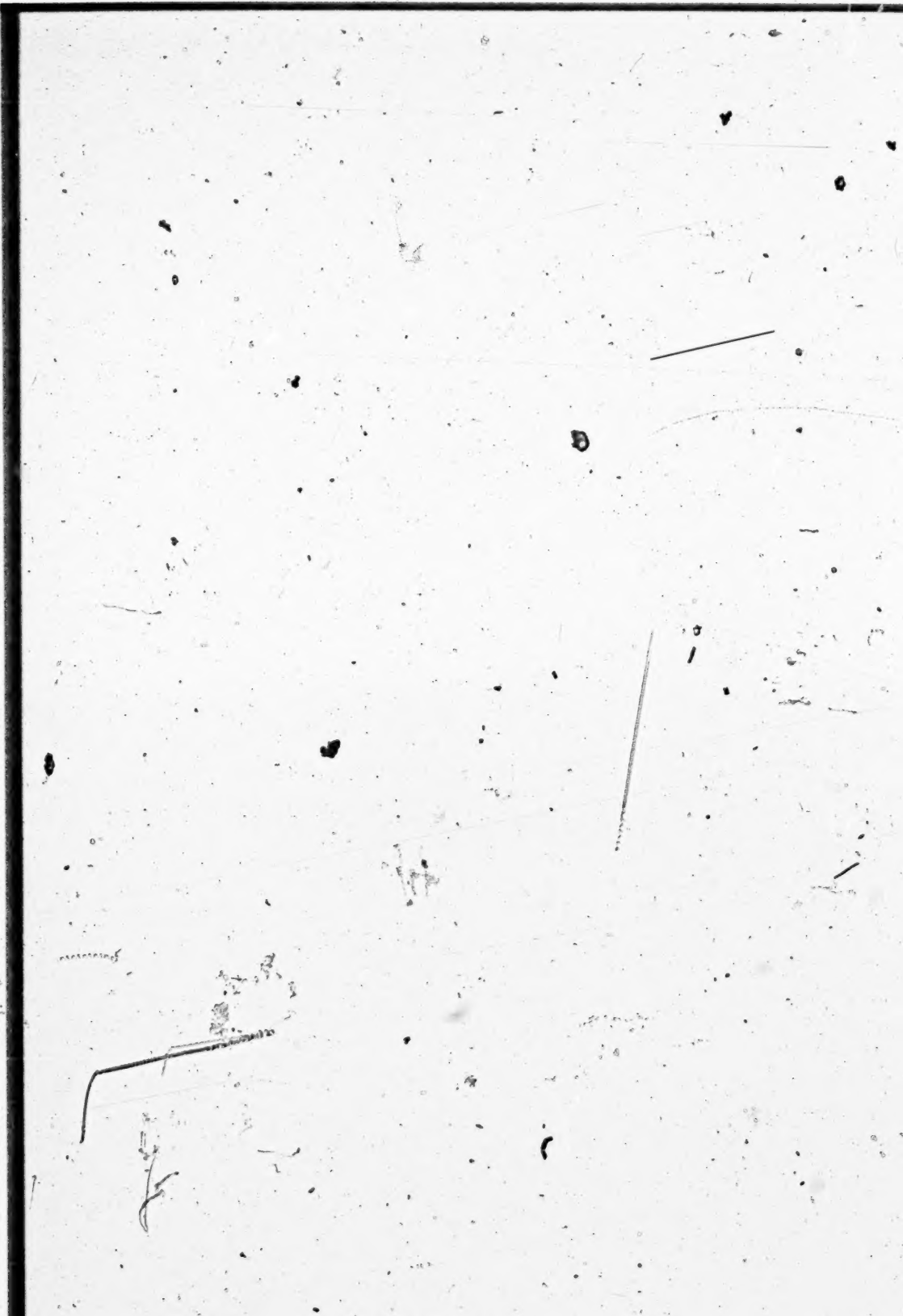
v.

E. I. DU PONT DE NEMOURS & COMPANY, *Respondent.*

REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

MARY HELEN SEARS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036
Attorney for Petitioner
Montecatini Edison S.p.a.

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.



INDEX

Page

A. The Duty of Full Disclosure of All Relevant Facts Owed to the Patent Office Throughout Every Phase of Patent Solicitation 2

1. The Decision Below Makes No Distinction Between Ex Parte and Inter Partes Patent Solicitation 3

2. The Applicable Rules and Statutes Do Not Recognize Respondent's Suggested Distinction Between Ex Parte and Inter Partes Patent Solicitation 6

3. The Duty of Full Disclosure to the Patent Office Has Always Had Both Ex Parte and Inter Partes Implications 8

4. The Number, Nature and Content of du Pont's Withheld Documents Is Not Relevant Here 10

5. The Real Reason Why du Pont Wants the Decision Below Left Unreviewed 11

B. Petitioner Does Not Seek "Absolute Abolishment of the Doctrine of Attorney's Work Product Immunity" 13

C. The Importance of the Present Controversy Militates in Favor of Review 14

D. Conclusion 15

LIST OF AUTHORITIES CITED

CASES:

Graham v. John Deere Co., 383 U.S. 1 (1966) 15

Hickman v. Taylor, 329 U.S. 495 (1947) 13, 14

Hogan v. *Zletz*, 43 F.R.D. 308 (N.D. Okla. 1967), *aff'd sub nom., Natta* v. *Hogan*, 392 F. 2d 686 (10 Cir. 1968) 4, 11

Kingsland v. Dorsey, 338 U.S. 318 (1949) 10, 12

Mallard, Ex Parte, 71 USPQ 294 (Com'r Pats. 1946) ..9, 10

Mallard v. *Kitto*, 69 USPQ 568 (N.D. Ill. 1946) 10

Page

Minnesota Mining & Mfg. Co. v. Gentex Corp., 153 USPQ 110 (D. Del. 1967), *reargument denied*, 153 USPQ 334 (D. Del. 1967) 3

Natta, In re, 264 F. Supp. 734 (D. Del. 1967), *aff'd*, 388 F. 2d 215 (3 Cir. 1968) 11, 12

Natta v. *Standard Oil Company of Indiana*, No. 1346, October Term, 1968, *cert. denied*, 23 L. Ed. 2d 223 (1969) 5

Natta v. *Zletz*, 405 F. 2d 99 (7 Cir. 1968) 14

Pfizer, Chas., & Co. v. *Federal Trade Commission*, 401 F. 2d 574 (6 Cir. 1968), *cert. denied*, 394 U.S. 920 (1969) 8, 10

Precision Instrument Mfg: Co. v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945) 8, 10, 12

Sperry Rand Corp. v. *International Business Machines Corp.*, 45 F.R.D. 287 (D. Del. 1968) 3

Sperti Products, Inc. v. Coca-Cola Co., 262 F. Supp. 148 (D. Del. 1966) 3

United States v. *Singer Mfg. Co.*, 374 U.S. 174 (1963) 8

STATUTES:

35 U.S.C. 24 4

35 U.S.C. 135 6

35 U.S.C. 146 10

REPEALED STATUTES:

R.S. 4915 10

RULES OF PRACTICE IN PATENT CASES:

Rule 265 (37 C.F.R. 1.265) 6

Rule 266 (37 C.F.R. 1.266) 6

OTHER AUTHORITIES:

1969 Committee Reports, Section of Patent, Trademark and Copyright Law, American Bar Association .. 12

Chemical and Engineering News, Vol. 47, No. 19, May 5, 1969 14

IN THE

Supreme Court of the United States

OCTOBER TERM, 1969

No. 322

MONTECATINI EDISON S.p.a., *Petitioner,*

v.

E. I. DU PONT DE NEMOURS & COMPANY, *Respondent.*

REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

In the opposition to the petition for writ of certiorari, respondent du Pont advances a plurality of arguments which, when realistically viewed in the context of the applicable law, effectively demonstrate the need for this Court's review of the questions raised in the petition.

A. THE DUTY OF FULL DISCLOSURE OF ALL RELEVANT FACTS OWED TO THE PATENT OFFICE THROUGHOUT EVERY PHASE OF PATENT SOLICITATION

Respondent du Pont—admittedly an applicant for a "patent on polypropylene" (R.Br. 8)*—opposes review of the decision below on the ground of a tenuous "distinction" *not recognized in the court below* between *ex parte* and *inter partes* patent solicitation. Respondent *admits* and professes to "fully agree" (R.Br. 6) that, for *ex parte* patent prosecution *only*, "one who seeks a valuable franchise from the government (*i.e.* a patent) owes to it something in the nature of a fiduciary's obligation of fair dealing"—to wit, a "duty of candor and honesty . . . to the Patent Office" (R.Br. 6). Respondent, in derogation of the decision below, the controlling rules and statutes and all applicable precedent,[1] opts for a *different* rule in *inter partes* patent solicitation (*i.e.*, patent interference proceedings). It seeks to justify itself by arbitrarily dubbing interferences as "adversary litigation" (R.Br. 1; see also R.Br. 4-7).[2]

---

* As used herein "R. Br." refers to respondent du Pont's "Brief in Opposition to Petition for a Writ of Certiorari"; "Pet." refers to the petition and the symbols "A", "N.Br.", "D.Br." and "N.R.Br." have the same significance as in the petition.

Unless otherwise stated, all emphasis herein is added emphasis.

[1] Respondent is *wrong* that "The authorities which Montecatini offers as establishing the duty of candor and honesty owing to the Patent Office arose in the *ex parte* context" (R.Br. 6). See *infra*, Section A3, p. 8.

[2] From this unsteady footing, du Pont leaps even more precariously to a *prima facie* unsupportable conclusion (Sec. B, *infra*, p. 13) that petitioner seeks "absolute abolishment of the doctrine of attorney's work product immunity" (R.Br. 1; see also R.Br. 6-7).

1. The Decision Below Makes No Distinction Between Ex Parte and Inter Partes Patent Solicitation

Respondent's present arguments constitute a belated effort to defend the rationale by which Judge Layton of the Delaware district court sought, in *Sperry Rand Corp.* v. *International Business Machines Corp.*, 45 F.R.D. 287 (D. Del. 1968), to resolve a conflict in decision within his own district between Judge Steel's decision in *Sperti Products, Inc.* v. *Coca-Cola Co.*, 262 F. Supp. 148 (1966), and Chief Judge Wright's decision in *Minnesota Mining & Mfg. Co.* v. *Gentex Corp.*, 153 USPQ 110 (1967), *reargument denied*, 153 USPQ 334 (1967). See Pet. 23-27. Judge Layton followed his own *Sperry Rand* decision in his August 23, 1968 order (Pet. 11a) in this case.

Before the court below, petitioner argued the tenuousness of Judge Layton's posited distinction between *ex parte* patent solicitation and *inter parties* (*i.e.*, interference) patent solicitation as set forth in *Sperry Rand* (N.Br. 33-40; see also N.R.Br. 2-4). Petitioner's position was that *no* immunities should be recognized for *any* form of patent solicitation. Du Pont did not effectively disagree with our premise that all patent solicitation should be treated alike. It contented itself solely with the oblique statement that "It is significant that . . . *Natta* v. *Hogan* [392 F.2d 686 (10 Cir. 1968)] and *Sperry Rand* v. *I.B.M.*, were each decided in the direct context of a patent interference" (D.Br. 16).

The Third Circuit agreed with us that there could be no distinction between kinds of patent solicitation, but concluded that attorney-client and work product immunities should be available for *all* patent solicitation. The Third Circuit explicitly stated:

> ". . . We cannot conclude . . . that the proper application of work product and attorney-client privi-

> lege will be detrimental to the public interest or offend paramount federal patent policy whenever a patent solicitation is involved. * * * We hold that in a particular situation both attorney-client and work product immunity may be available to the solicitation of a party's own patent. . . ." (Pet. 4a-5a)

The Tenth Circuit decision in *Natta* v. *Hogan*, 392 F.2d 686, upon which the decision below importantly rests, affirmatively afforded these immunities to all "patent proceedings", including *ex parte* patent solicitation. In particular, it affirmed the trial court holding of attorney-client privilege for documents numbered 2, 9, 10 and 12. The district court opinion *sub nom. Hogan* v. *Zletz*, 43 F.R.D. 308, 316-317 (N.D. Okla. 1967), shows that documents 2, 9 and 10 dated March 22, 1954, January 5, 1956 and January 6, 1956, respectively, were prepared well before the admitted September 9, 1958 declaration date of Interference 89,634 (R.Br. 3). Since all of these three obviously relate to *ex parte* patent solicitation—there being no interference in existence at their date—*Natta* v. *Hogan* stands as express precedent for the proposition that *ex parte* patent solicitation activities are subject to privilege and work product immunities. It was *followed* below.

These Third and Tenth Circuit decisions have already led to a recognition of attorney-client and work product immunities for documents relating to the *ex parte* solicitation of a patent application in two different district court proceedings.

In one of these, a 35 U.S.C. 24 proceeding allegedly ancillary to Interference 89,634 instituted by du Pont against petitioner in the District Court for the District

of Delaware, the Special Master's report indicates that "approximately 14,200" pages of documents (1b, *infra*) were reviewed for immunity claims. The Special Master rejected du Pont's arguments concerning a "distinction between *ex parte* and *inter partes* patent solicitation". He said "I find no such distinction in the Court of Appeals' opinion" (2b, *infra*).[3]

In the other proceeding, also ancillary to Interference 89,634, Civil Action No. 66 C 1221 in the District Court for the Northern District of Illinois, Judge James B. Parsons relied on the Tenth Circuit decision in *Natta* v. *Hogan* and the decision below to find "lawyer-client privilege" for an unadumbrated mass of documents, including "sixty volumes of notes" (2b, *infra*.)[4]

These two pending cases demonstrate the magnitude of the difficulties posed by the decision below. These difficulties are not, as du Pont would have it, limited to the four documents presently in issue in this case. See, *infra*, Section A4, p. 10.

---

[3] The Special Master's report has not yet been approved by the district judge and is subject to review in the court below. It nonetheless cogently illustrates the construction which lower federal courts and lawyers alike will place upon the plain language of the decision below, absent intervention by this Court.

[4] Civil Action No. 66 C 1221 is the case which spawned *Natta* v. *Standard Oil Company of Indiana*, No. 1346, October Term, 1968, referred to at R.Br. 7, n. 3. The petition in that case (6a-22a) reproduced the list of disputed documents submitted by Standard Oil up to its date. As noted in the petitioner's reply brief filed May 9, 1969, that list was later "supplemented by a 'category 4', including innumerable additional pages of withheld material" (p. 1, n.2).

2. The Applicable Rules and Statutes Do Not Recognize Respondent's Suggested Distinction Between Ex Parte and Inter Partes Patent Solicitation

35 U.S.C. 135 pertaining to "Interferences" is embraced with a group of sections of Title 35 of the United States Code under the heading "Chapter 12.—*Examination of Application*". Thus, even the statute itself recognizes that patent interferences are just one possible step in the solicitation of a patent enforceable against the public.

Du Pont's effort to remove interferences from the realm of patent solicitation by virtue of their *inter partes* character is all the more tenuous when the apposite Patent Office rules governing the proceedings *subsequent* to interference are considered. Respondent *emphasizes* that "once an interference is declared, all *ex parte* prosecution is suspended (37 C.F.R. § 1.212) and the proceeding is then conducted upon an adversary basis . . . . " (R.Br. 2), but *ignores* 37 C.F.R. 1.265 and 1.266 relating respectively to "Status of Claims of Defeated Applicant After Interference" and "Action After Interference".

37 C.F.R. 1.266(b) in particular specifies that

> "After judgment of priority, the application of any party [to an interference] may be held subject to *further* [*ex parte*] *examination, including interference* with other applications."

Thus in one stroke 37 C.F.R. 1.266(b) demonstrates that an "interference" *is a part of the solicitation of a patent application* and demolishes respondent's argument that a "duty of candor and honesty owing to the Patent Office" (R.Br. 6) is or could be restricted to *ex parte* patent prosecution.

Respondent's argument effectively would have this duty operate during "the initial filing and processing of patent applications . . . upon an *ex parte* basis . . ." (R.Br. 2), but cease during an interference "conducted upon an adversary basis" (R.Br. 2) and—presumably—resume after termination of the interference. *If* du Pont were right, a patent applicant whose application became involved in an interference would owe the Patent Office "the duty of candor and honesty" *before* and *after* the interference, but could with impunity act untruthfully or dishonestly during the interference itself. Under such mode of operation, he might conceal from his opponent in the interference facts sufficiently adverse to deprive him of priority—and having thus unfairly eliminated the opponent, would then be relegated to further *ex parte* prosecution wherein he would be obliged to confess the deficiencies of his case, including his perfidy during the interference, to the Patent Office. Obviously, du Pont is wrong. The interference opponent, as a member of the public exceptionally well qualified to assist the Patent Office in assessing the relevant facts, *must* be entitled to their full revelation just like the Office itself. See note 5, *infra*, p. 8.

Du Pont's arguments are not only wholly illogical, but in the teeth of "The authorities which Montecatini offers as establishing the duty of candor and honesty owing to the Patent Office" (R.Br. 6). These authorities, contrary to du Pont's *ipse dixit*, *did not at all* arise solely "in the *ex parte* context" (R.Br. 6).

3. The Duty of Full Disclosure to the Patent Office Has Always Had Both Ex Parte and Inter Partes Implications

In *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945), this Court found both parties to patent infringement litigation guilty of fraud on the Patent Office and unclean hands, based upon the prior conduct of both in a *patent interference proceeding* which preceded the issuance of the patents in litigation. During the *interference* both had "knowledge or reasonable belief" of a perjury committed by one Larson, "not revealed to [and hence deliberately suppressed from] the Patent Office". In lieu of exposing the perjury, Larson's opponent Automotive "chose to enter into an outside settlement [of the interference] with . . . Precision . . . whereby Larson conceded priority" (324 U.S. at 819).[5]

Charles Pfizer & Co. v. *Federal Trade Commission*, 401 F.2d 574 (6 Cir. 1968), *cert. denied*, 394 U.S. 920 (1969), cited at Pet. 18, involved inequitable and

---

[5] In *United States* v. *Singer Mfg. Co.*, 374 U.S. 174 (1963), this Court condemned a similar collusive interference settlement involving a joint effort to suppress prior art from the Patent Office as constituting one step in a civil antitrust violation. As Mr. Justice White, concurring, observed, "Whatever may be the duty of a single party to draw the prior art to the Office's attention . . . clearly collusion among applicants to prevent prior art from coming to or being drawn to the Office's attention is an inequitable imposition on the Office and on the public [citing *Precision*]. . . ." (374 U.S. at 200)

Manifestly, unilateral suppression of relevant facts by one party to a patent interference (whether or not involving prior art) is just as much "an inequitable imposition on the Office and on the public" as "collusion among applicants" to suppress relevant information. See the cases discussed at Pet. 16-21. Each of the opposing parties in an interference is *himself* a member of the "public", entitled to strict enforcement of the uncompromising duty of full disclosure of all relevant facts to the Patent Office.

fraudulent patent solicitation by Pfizer in collusion with American Cyanamid Company throughout the course of two *interferences* and various interspersed sequences of *ex parte* prosecution. The decision makes no distinction between the duty owed to the Patent Office during *ex parte* solicitation and that due in *inter partes* (interference) solicitation.

Of the seven reported cases (Pet. 20, n. 20) in which the Commissioner of Patents has actually stricken a patent application from the Patent Office files, one—*Ex parte Mallard,* 71 USPQ 294 (Com'r Pats. 1946)—involved an effort in the course of an interference "to defraud both the Patent Office and the court" by advancing falsified testimony and exhibits "to obtain the allowance of the claim . . . which was involved in interference" (71 USPQ at 295). The Commissioner held "the duty of candor and honesty owing to the Patent Office" (R.Br. 6) had been violated. He said that "fraud in the procurement of any claim of a patent is sufficient to vitiate the entire patent. . . . [I]f Mallard had prevailed in the interference and obtained a patent containing the claim there involved, as well as other claims, and if the fraud had then been discovered, the entire patent would have been rendered void. * * * One who, instead of complying with the requirements of the statutes and of the rules of the Patent Office made pursuant thereto, attempts to evade them by fraudulent means, must be held to have forfeited his right to a patent on the application involved in the fraudulent proceeding." (71 USPQ at 296-297)

4. The Number, Nature and Content of du Pont's Withheld Documents Is Not Relevant Here

Du Pont's protestations that we are attempting "to obtain and exploit four (4) analyses of the matters in litigation prepared by . . . attorneys for the eyes of their client's management and co-counsel" (R.Br. 1) are *not relevant* to the issue of whether review should be granted. In *Mallard, supra,* the attempt to defraud both the Patent Office and the court involved *just four* documents—three fraudulently altered after preparation and one about which false testimony was given. See *Mallard* v. *Kitto,* 69 USPQ 568 (N.D. Ill. 1946), the R.S. 4915 proceeding which precipitated the Commissioner's *Mallard* decision; especially fact findings 15 and 16.[6]

Manifestly, *even one* really important document may be the basis for winning or losing an entire case. The pending Delaware and Illinois proceedings discussed *supra,* pp. 4-5, illustrate that the problems posed by the petition far transcend du Pont's four documents in any event.

Precision, Pfizer, Kingsland v. *Horsey,* 338 U.S. 318 (1949) (Pet. 18), and the cases cited at Pet. 18, n. 18, are careful *not* to exempt so-called "privileged" information from the scope of the duty of full disclosure owing to the Patent Office. At Pet. 21-23 we have shown that the Third Circuit's imputation into these cases of an *unexpressed* exception for state law-based immunity concepts is in conflict with this Court's decisions establishing the federal supremacy of the patent laws. On this basis, the nature and content of du

[6] R.S. 4915 is the predecessor statute to 35 U.S.C. 146 providing for review of interference decisions by equity courts.

Pont's documents is of no moment to the need for review.[7]

5. The Real Reason Why du Pont Wants the Decision Below Left Unreviewed

By positing its opposition to review upon a rationale not accepted in the court below, du Pont tacitly concedes that both the Third Circuit in this case and the Tenth Circuit in *Natta* v. *Hogan, supra,* were wrong in concluding that privilege and work product immunities are available in *ex parte* patent solicitation. Necessarily, it is thereby conceded that the Third and Tenth Circuits have placed themselves in direct conflict with "The authorities which Montecatini offers as establishing the duty of candor and honesty owing to the Patent Office" (R.Br. 6).

Du Pont nonetheless wants to avoid review and have these *admittedly* at least partially incorrect appellate decisions stand because, as the world's largest chemical company and the owner of countless patents, it

---

[7] Du Pont says that "the record affirmatively discloses that all of the documentation and witnesses' knowledge underlying these [controverted four] legal opinions were furnished to Montecatini" (R.Br. 3-4), but as we stated in the petition, du Pont has offered no proof to this effect (Pet. 12). We have had no opportunity to check its accuracy for ourselves, having been foreclosed access to the disputed documents (A74-75). The Third Circuit's overgenerous conclusion of "no attempt by du Pont to shield from discovery" "pertinent research, tests and experiments" (Pet. 12), was reached absent explicit factual information on the point and with no assurance that the "data" concededly contained in the disputed documents was *ever* furnished to petitioner.

The record being devoid of any proof on this point, du Pont cannot exploit its own self-serving version of facts that are at best peripheral to the issues posed in order to evade review.

welcomes the inroads upon *Precision, supra,* and *Kingsland* v. *Dorsey, supra,* which will necessarily result.

Du Pont's tacit admission here of at least partial error in the Third and Tenth Circuit decisions—if effective to induce this Court to deny review—will in no sense bind du Pont in the future. If du Pont can prevent review it will be free to advance blanket privilege and work product claims to shield its own patent solicitation procedures, already recognized in the district court as expedient in the specific context of Interference 89,634.[8]

Fraud and inequitable conduct in patent solicitation, as the petition notes (p. 19), are persistently a subject of great concern to Congress and the federal courts. Presently, a plurality of government and bar-association groups are seeking at least partial solutions to this increasingly aggravated problem. It is common knowledge that both the Commissioner of Patents and the National Council of Patent Law Associations have undertaken studies directed to the promulgation of conduct "guidelines" on patent solicitation. See for example the "1969 Committee Reports" of the Section of Patent, Trademark and Copyright Law of the American Bar Association, p. 243. The same committee reports show at p. 124 that this section itself has designated a *new* "Subcommittee C" of its Standing Com-

---

[8] See A13, 264 F.Supp. 734 at 737 (D. Del. 1967), *aff'd* 388 F.2d 215 (3 Cir. 1968), holding *inter alia*, that "it is to be borne in mind that du Pont in presenting its case [in Interference 89,634] . . . had the advantage of being able to place in evidence documents tending to support its position and of suppressing any material which might tend to weaken its case".

The "9573 pages of documents" (R.Br. 4, n. 2) that du Pont says it later produced were awarded petitioner by the district and appellate courts in an effort to correct the recognized inequity.

mittee 103, "Patent Office Affairs—Patents", having as its purpose "to make a study of reported decisions wherein the issue of 'fraud on the Patent Office' was raised and to make recommendations as to how the situation of 'fraud on the Patent Office' can be alleviated or obviated." [9]

This Court has ever been alert to the problem of fraud in patent solicitation. It should act promptly to safeguard the full disclosure requirements of the patent laws and their federal supremacy against the incursions now permitted by the Third and Tenth Circuit decisions.

B. PETITIONER DOES NOT SEEK "ABSOLUTE ABOLISHMENT OF THE DOCTRINE OF ATTORNEY'S WORK PRODUCT IMMUNITY"

The petition (Pet. 27-33) evinces our concern that the decision below abridges the attorney's work product doctrine as properly defined for ordinary civil litigation in *Hickman* v. *Taylor*, 329 U.S. 495 (1947). As

---

[9] Public discussion of the problem among educational and bar groups is also on the uptrend. On July 9 to 11, 1969 the Practising Law Institute held a seminar on "Consequences of Fraud and Patent Law Today" which was attended not only by many practicing private and corporate-employee lawyers, but by representatives of the Patent Office, the Department of Justice and the Federal Trade Commission.

On September 25 and 26, 1969 the Federal Bar Association, its Foundation, and the Government Patent Lawyers Association are jointly sponsoring a "Briefing Conference on Patent Law" which —from the printed announcements—will include two separate considerations of fraudulent patent solicitation. One is entitled "Fraud on the Patent Office—Patent-Antitrust Relation" and the other—a speech to be given by Mr. S. William Cochran, Deputy Solicitor of the United States Patent Office—is entitled "Historical Review of Fraud in Patent Procurement, The Standards and Procedures for Doing Business Before the Patent Office".

we stated, "the divergent case law developments in the work product doctrine since *Hickman* eloquently demonstrate that the time is ripe for this Court to look again at" the work product problem (Pet. 27). We asked for "a definitive guidelines opinion" (Pet. 33).

Recognition of work product immunity for patent solicitation in any form is but *one* of numerous departures from the letter and spirit of *Hickman* that are explicit on the face of the decision below. Review by this Court would have the effect of *revitalizing*—*not* "abolishing"—the work product doctrine within its proper ambit.[10]

C. THE IMPORTANCE OF THE PRESENT CONTROVERSY MILITATES IN FAVOR OF REVIEW

Du Pont argues (R.Br. 7-8) that the duration of pendency before the Patent Office of the patent applications involved in Interference 89,634 should be the basis for refusing review—and blames non-resolution of the interference at this time upon Montecatini's insistence "in seeking the truth about who is entitled to this patent", *Natta* v. *Zletz*, 405 F.2d 99, 101 (7 Cir. 1968), by the mechanism of obtaining relevant documents from its opponents.

Du Pont neglects to inform this Court that the same arguments advanced before the Patent Office in an effort to brand Montecatini as dilatory in the interference have found no favor. See 4b, *infra*. In the article entitled "Round Won in PP Patent Tangle" published in *Chemical and Engineering News* for May 5, 1969, p. 7, it was stated with specific reference to Interference 89,634 and the patent which the various

[10] As shown at Pet. 21, a decree that work product immunity is not available in patent solicitation *could only benefit* the public.

parties are therein attempting to obtain, that "At stake are licensing fees on a plastic whose U. S. production is valued at about $200 million this year." [11]

In *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966), this Court took particular pains to point out that the Patent Office, not the courts, has the primary responsibility for "sifting out unpatentable material"—thereby ensuring that defective patent applications do not become patents. In the present controversy involving a prospective patent of major commercial importance, this Court has a rare opportunity to assist the Patent Office in discharging that responsibility by ensuring a full opportunity to decide in the light of all the relevant information.

Indeed, even if this controversy *could* be viewed as one involving *only* the potential polypropylene patent which may emanate from Interference 89,634—and it manifestly has virtually infinite ramifications in the patent field—the size of the relevant industry that the patent will dominate and the potential commercial value of the patent itself make this controversy one of vast public importance.

D. CONCLUSION

The petition should be granted.

Respectfully submitted,

MARY HELEN SEARS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036
Attorney for Petitioner
Montecatini Edison S.p.a.

---

[11] The article is reproduced at p. 1a of the "Reply Brief in Support of Petition for Writ of Certiorari" in No. 1346, October Term, 1968.